

REMARKS

By the above actions, claims 1-16 have been replaced by new claims 17-30. Additionally, accompanying this response are new drawings for replacing all of the drawings currently on file. In view of the actions taken and the following remark, further consideration of this application is now requested.

With regard to the objection to the drawings, the new sheets of drawings contain only Figs. 1, 2 & 3, so that a reference to Figs. 1a & 1b in the specification is no longer necessary. As for the submission of a proposed drawing with changes marked in red, under current PTO drawing practice, such red marked drawings are no longer required and it is sufficient to submit new replacement sheets with an explanation of the changes in the remarks section of the accompanying amendment paper; see, e.g., the Notice signed by Deputy Commissioner for Patent Examination Policy, Steven Kunin, dated January 31, 2003. With regard to the accompanying new drawings, Figs. 1 & 2 conform essentially with original Figs. 1 & 2 with improved clarity. New Fig. 3 has been modified relative to original Fig. 3 by the addition of the illumination beam and beam splitter, 112, 114 and so as to otherwise conform with the manner of illustration used in Fig. 1; in this regard, it is noted that Fig. 2 is indicated as showing the optics of Fig. 1 and Fig. 3 is described in the first sentence of paragraph [0022] as using the same optics as shown in Fig. 2. As for the failure to show the specimen on a surface of the holder facing away from the objective lens (a showing of which was presented via disapproved Fig. 1b), in view of the amendments to the claims eliminating this recitation, submission of a showing thereof is now unnecessary. Accordingly, withdrawal of the objections to the drawings and approval of the submitted new drawings are in order and are now requested.

Former claims 10 & 11, 15 & 16 were rejected under 35 U.S.C. § 112, first paragraph as containing inadequately disclosed subject matter. With regard to claims 10 (new claim 24) & 11, since placement of the specimen on the side of the holder facing away from the objective is no longer expressly claimed, this basis for rejection is not applicable to the present claims. Claim 15 (new claim 29) is in conformance with the disclosure of paragraph [0025] which teaches that laser light from outside the reflection means (which is reflected on the reflective boundary surface of the reflection means and specimen) is reflected at an angle which results in TIRF. The "small cavity" term of claim 16 has been eliminated from replacement claim 30. Accordingly, it is submitted that the claims as now presented are fully

support by an enabling disclosure, so that the outstanding rejection under § 112, first paragraph should be withdrawn and such action is now requested.

Prior claims 1, 4, 5, 7, 8, 10, 13, and 16 were rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of the Doyle patent. While the Doyle patent disclosures a microscope which is adapted for transmitted light illumination and reflected light illumination of a specimen, in contrast to the present invention, the Doyle microscope accessory is not adapted for epi-fluorescence illumination. Furthermore, the Doyle microscope accessory does not have a light source which is adapted to allow a change between different wavelengths for producing, alternately, transmitted light illumination and epi-fluorescence illumination. Accordingly, since new claim 17 provides that the "light source is adapted to allow a change between different wavelengths for producing, alternately, transmitted light illumination and epi-fluorescence illumination," Doyle cannot anticipate or even render obvious the subject matter of claim 17 and those claims which depend from claim 17. Therefore, withdrawal of the rejection under § 112 based on the patent to Doyle is in order and is now requested.

Prior claims 1, 2, 9, 10, 13, and 14 were rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of the White et al. patent, while claim 3 has been rejected under 35 U.S.C. § 103 as being unpatentable over this reference. However, like the Doyle patent, the White et al. patent fails to disclose a light source which is "adapted to allow a change between different wavelengths for producing, alternately, transmitted light illumination and epi-fluorescence illumination," White et al. disclosing a fluorescence microscope with a light source 11 which emits light at a single wavelength of 1047 nm (col. 7, lines 11 & 12). The Examiner's position that has been stated with respect to claim 3 has been noted. However, the mere fact that the use of multiple wavelengths *may* have been known (if such is so well known why has the Examiner been unable to cite a reference to support his opinion as to such usage) such does not mean that it would have been obvious to use a variable wavelength light source for White et al.'s purposes, nor does that mean that a variable wavelength lights source would be used instead of two different light sources. Moreover, the mere use of a variable light source would not teach a light source which alternately produces "transmitted light illumination and epi-fluorescence illumination" as set forth in claim 17 from which claim 3 is dependent.

Furthermore, while the emitted fluorescent light in White et al. is reflected by their reflector 30, contrary to the Examiner's assessment, the reflector 30 does not reflect the illumination light (see, col. 5, lines 42-46 & col. 7, lines 16 & 17 "reflectance less than 5% at 1047"). As a result, the White et al. patent cannot anticipate or even render obvious the invention defined by claim 17, so that the rejections under §§ 102 & 103 based thereon should be withdrawn and such action is now requested.

Claims 4, 5, 7, 8, 12, 15, and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the White et al. and Pinkel et al. patents. However, this rejection appears to be based on the same erroneous assessment of White et al. as made in the rejections based on this reference by itself. That is, this rejection suffers from the deficiencies noted above relative to the claim 17, and furthermore, since White et al. does not seek to reflect illumination light, but rather desires his reflector 30 to be reflective as to such light, it would not be obvious, as contended by the Examiner, to use a concave reflective means to increase the collection of illumination light on the basis of the Pinkel et al. teachings. However, even if a concave mirror were to be used, all of the deficiencies noted above with regard to the disclosure of the White et al. patent would still exist. Thus, the claims invention is not obvious from any appropriate combination of the White et al. and Pinkel et al. patents, so that withdrawal of this rejection is in order and is now requested.

Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the Doyle and Allingham patents. However, nothing in the Allingham patent would overcome the shortcomings of the Doyle patent noted above relative to claim 17, so that the combination thereof with Doyle cannot render the subject matter of claim 17 unpatentable, irrespective of whether or not Doyle's mirror were to be constructed in the manner of the Allingham mirror. Thus, this rejection should also be withdrawn.

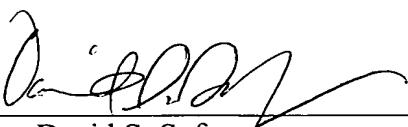
Claim 9 & 11 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the Doyle and Lanni et al. patents. Here again, since the Lanni et al. disclosure does not overcome the shortcomings of the Doyle patent noted above relative to claim 17, even if an immersion fluid were to be used in the Doyle patent based on their teachings, such would not render the present invention obvious. Therefore, withdrawal of this rejection is also requested.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which

could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,

By:


David S. Safran
Registration No. 27,997

NIXON PEABODY LLP
8180 Greensboro Drive, Suite 800
McLean, Virginia 22102
Telephone: (703) 770-9300

Dated: February 21, 2003